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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,107	01/10/2000	YONG CHEOL PARK	0465-0656P-S	3918

7590 04/09/2002

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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/480,107

Applicant(s)

Park

Examiner

Gautam R. Patel

Art Unit

2653

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Feb 4, 2002

2a) ☒ This action is FINAL.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-23 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-23 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☒ The proposed drawing correction filed on Feb 4, 2002 is: a) ☐ approved b) ☒ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Response to Amendment

1. This is in response to amendment filed on 2-4-02 (Paper # 5).
2. Claims 1-23 remain for examination. Claims 10-23 are newly presented for examination.

Drawings

3. The drawings are objected for following reasons:
Drawing changes has been received. MPEP § 608.02 g requires that drawings be labeled as "Prior Art". The figures are now labeled as "Background Art".
Figures are not designated by a legend such as "Prior Art". The legend is necessary in order to clarify what applicant's invention is (see MPEP § 608.02g).

Explanation and/or correction are required

OBJECTION TO NEW MATTER ADDED TO THE SPECIFICATION

4. The amendment filed on 2-4-02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:
DMA is reset (step 603) to an initial or nullified state; and
nullifying any previously stored address information as added to the specification and to the claims

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 U.S.C. § 112

5. Claims 1-13 and 20-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The added material which is not supported by the original disclosure is setting to an initial or nullified state and nullifying any previously stored address information is not mentioned at all in the original specification or explained such that one of ordinary skill in the art would have been able to use it.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

New claims 14-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bish et al., US. patent 5,235,585 (hereafter Bish).

As to claim 14, Bish discloses the invention as claimed [see Figs. 1-9] including resetting a location information of spare area and converting spare area to user area, comprising the steps of:

- a. Receiving an instruction to format the recording medium [inherently present];
- b. Resetting a location information stored on the recording medium in response to the instruction; and

c. Transferring secondary defect information with a new PDL to format the recording medium according to instruction [col. 6, lines 13-24 and col. 6, line 62 to col. 7, line 6].

7. As to claim 15, Bish discloses:
registering sectors judged to have defects into new PDL if the recording medium is to be formatted with certification [col. 3, lines 42-54; col. 5, line 65 to col. 6, line 12 and col. 7, line 47 to col. 8, line 30].

8. As to claim 16, Bish discloses:
disposing an old SDL of the secondary defect information if the recording medium is to be formatted with certification [col. 7, lines 7-46]

9. As to claim 17, Bish discloses:
registering all sectors previously registered in an old SDL of secondary defect information into the new PDL if the recording medium is to be formatted without certification [col. 9, line 52 to col. 10, line 45 and fig. 9].

10. As to claim 18, Bish discloses:
the location information of the supplementary spare area is stored in a SDL blocks of a DMA of the recording medium [col. 6, line 31 to col. 7, line 26 and fig. 4]

11. As to claim 19, Bish discloses:
the location information includes start and end addresses of the supplementary spare area on the recording medium [inherently present].

12. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

13. Claims 22-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bish as applied to claims 14-19 above.

Regarding claims 22-23, Bish discloses the transferring and resetting steps. Bish does not specifically disclose that the resetting step is performed first or second as compared to transferring step, such limitations are merely a matter of design choice and would have been obvious in the system of Bish. Bish that sectors are listed in ascending order according to track and sector numbers. The limitations in claims 22 and 23 do not define a patentable distinct invention over that in Bish since both the invention as a whole and Bish are directed to assigning the sectors in order they are available and choose sectors which are near to the original sector thus keeping track movement to minimum for saving time. The order in which the transferring or resetting takes place presents no new or unexpected results. Therefore, to have any order in which to transferring and resetting steps are done in Bish would have been a matter of obvious choice to one of ordinary skill in the art.

Bish was cited as prior art reference in paper no. 3, mailed 10-3-01.

14. Applicant's arguments filed on 2-4-02 (Paper # 5) have been fully considered but they are not deemed to be persuasive for the following reasons.

15. In the REMARKS, the Applicant argues as follows:

A) That: "Regarding independent claim 1, ... nullified state .. " [page 15; REMARKS].

As to claims 1-13 **new matter** was introduced. See rejection 112 first, supra.

B) That: "Independent claim 14 and its dependent claims 15-23 contain similar subject matter as claims 1-13." [page 17, para. 4; REMARKS].

Please see rejection of claim 14-23, supra.

16. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Contact information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

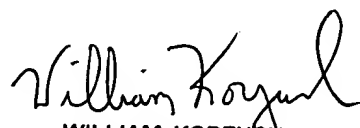
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. William Korzuch, can be reached on (703) 305-6137.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.



Gautam R. Patel
Patent Examiner
Group Art Unit 2653

April 6, 2002



WILLIAM KORZUCH
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